PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/679,563 Confirmation No.: 3117
Applicant : Gary B. McAlister
Filed : October 6, 2003
TC/A.U. : 3733
Examiner : Comstock, David C.
Title : RETRIEVAL DEVICE MADE OF PRECURSOR ALLOY CABLE
Docket No. : 1001.1658102
Customer No. : 28075

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
PO Box 1450
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CERTIFICATE FOR ELECTRONIC TRANSMISSION: The undersigned hereby certifies that this paper or papers, as described herein, are being electronically transmitted to the U.S. Patent and Trademark Office on this 27 day of December, 2007.

By
JoAnn Lindman

Dear Sir:

Appellant respectfully requests a Pre-Appeal Brief Review of the pending application. A Notice of Appeal is filed herewith.

Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers, if appropriate. Please charge any additional fees or credit overpayment to Deposit Account No. 50-0413.

Applicants submit that the Examiner's rejections contain at least the following clear errors and/or omissions of one or more essential elements needed for a prima facie rejection. In the Final Office Action mailed July 2, 2007 and the Advisory Action mailed November 14, 2007, claims 38-58 are pending and all are rejected.

Claims 38-44 and 46-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Gibbs et al. in U.S. Patent No. 5,330,482. Applicants respectfully traverse this rejection and request reconsideration of the remarks set forth in the replies filed October 24, 2007 and April 17, 2007.

In these prior replies, Applicants indicated that Gibbs et al. fails to teach or suggest all the claim limitations. For example, Gibbs et al. fails to teach or suggest a body including a cold formed nickel-titanium alloy having a transformation temperature greater than a mammalian body temperature, wherein the nickel-titanium alloy exhibits linear pseudoelasticity regardless of stress applied to the body as recited in independent claim 38. The Examiner indicated that Gibbs et al. discloses the claimed invention. We respectfully disagree.

In the Final Office Action, the Examiner "noted that the device of Gibbs et al. is not heat treated until *after* the basket portion has already been formed (see col. 3, lines 43-45)." (emphasis in original). Apparently elaborating on this point, in the Advisory Action the Examiner went on to state that "the device of Gibbs et al. is cold formed into its final configuration or shape before being heat treated." Additionally, the Examiner indicated that "[a]fter cold forming, the nickel-titanium alloy necessarily exhibits linear pseudoelasticity regardless of the stress applied to it." (emphasis added). We respectfully disagree.

The Examiner appears to be assuming that prior to heating the wire basket 77, the inner monofilament wires 11 must necessarily exhibit linear pseudoelasticity and, because of this, claims 38-44 and 46-57 are anticipated. We are unsure why such an assumption has been made as nothing in Gibbs et al. expressly states or suggests that this is the case. Indeed, Gibbs et al. is completely silent as to linear pseudoelasticity.

Applicants specification teaches how superelastic materials, not materials that exhibit linear pseudoelasticity, are conventionally used in the manufacturing of medical devices. For example, the specification at page 8, lines 16-19 recites that:

> In addition to requiring heat treatment of the precursor alloy to produce the superelastic material, a conventional retrieval device also requires heat treatment during the formation of the basket so that the superelastic wires maintain their shape. (emphasis added).

It can be appreciated that if a straightened, superelastic wire was used to form a non-linear (i.e., shaped) object or structure, the superelastic material would resist changes in shape and would require, for example, heat treatment to set the new shape. This appears to be exactly what is happening in Gibbs et al. For example, Gibbs et al. indicate that "[a]fter wire basket 77 has been formed, heat is applied to wire basket 77 to set the shape memory characteristics of inner monofilament wires 11." Col. 3, ll 43-45. This is consistent with conventional manufacturing processes where a superelastic material is provided, bent into a desired new shape, and then heat is applied to "set the shape memory characteristics" of the material.

Based on these remarks, it can be appreciated that Gibbs et al. does not expressly teach or suggest a material that exhibits linear pseudoelasticity or that a material that exhibits linear pseudoelasticity is necessarily present in Gibb et al. Because of this, Gibbs et al. cannot anticipate claim 38 or claims 39-44 and 46 depending therefrom.

Regarding claims 47-52, for similar reasons Applicants respectfully submit that Gibbs et al. fails to teach or suggest a nickel-titanium alloy that is in a martensitic phase when the body is stressed into a first shape and when the body is stress relieved to a second shape, and wherein the nickel-titanium alloy has a transformation temperature >37 degrees C as recited by independent claim 47. Gibbs et al. is completely silent as to these properties and/or characteristics. Accordingly, Gibbs et al. does not teach or suggest these claim limitations or make any disclosure that indicates that they are necessarily present. Based on these remarks, Applicants respectfully submit that claim 47 as well as claims 48-52 depending therefrom are patentable over Gibbs et al.

Regarding claims 53-57, for similar reasons Applicants respectfully submit that Gibbs et al. fails to teach or suggest the steps of providing a cold formed nickel-titanium alloy, setting a transformation temperature >37 degrees C, cold forming the struts into a body having a shape, and stressing the body into a first shape wherein the nickel-titanium alloy is in a martensitic phase as recited by independent claim 53. Again, Gibbs et al. is completely silent to these steps or to the use of material having these properties and/or characteristics in these steps. Accordingly, Gibbs et al. does not teach or suggest these claim limitations or make any disclosure that indicates that they are necessarily present.

Based on these remarks, Applicants respectfully submit that claim 53 as well as claims 54-57 depending therefrom are patentable over Gibbs et al.

Claims 45 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibbs et al. MPEP §2143 states that in order to establish a prima facie case of obviousness, all the claim limitations must be taught or suggested. For the reasons set forth above, Gibbs et al. fails to teach or suggest all the claim limitations of independent claims 38 and 53. Consequently, claims 38 and 53 are patentable over Gibbs et al. Because claims 45 and 58 depend from claims 38 and 53, respectively, they are patentable for the same reasons as claims 38 and 53 and because they add significant elements to distinguish them further from the art.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that the claims are now in condition for allowance, issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Gary B. McAlister

By his Attorney,

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